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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,736	02/08/2001	Seong Ryul Lee	1581-02	6900

7590 06/15/2004

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,736

Applicant(s)

LEE, SEONG RYUL

Examiner

Stephen Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Korea on July 27, 2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the citizenship of each inventor.

Specification

The specification is objected to because it contains a plurality of hypertext internet links, specifically to www.carsforsale.com. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

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thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial*

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Group, Inc. 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998). Together, the "technological arts" and "useful, concrete, and tangible result" judicial review standard, result in a comprehensive examination standard wherein the "technological arts" is one element and the "useful, concrete, and tangible result" is another complementary element.

This comprehensive examination standard was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

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The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. The Board of Patent Appeals and Interferences (BPAI) have recently acknowledged this dichotomy in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BPAI 2001).

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Claims 1-2, 5-12, 15-26, 31, and 33 are rejected under 35 U.S.C. 101 because the independently claimed invention does not recite a useful, concrete, and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998) such that the claimed invention is within the technological arts under *In re Waldbaum* 173 USPQ 430 (CCPA 1972) wherein the phrase "technological arts" is synonymous with "useful arts" as it appears in Article I, Section 8 of the United States Constitution. In this claim, it is considered that a concrete and tangible result within the technological arts is not recited. Specifically, the recitation of displaying, allowing, wireless, address, information, transmitting, providing, determining, sending, executing, and assigning steps is considered not to produce a concrete result because a result cannot be assured or is not reproducible. The displaying, allowing, wireless, address, information, transmitting, providing, determining, sending, executing, and assigning steps recitation is considered an abstract concept that is non-enabling because those steps are not considered to be within the technological arts since, the steps can be performed without structural interaction or mechanical intervention. Furthermore, under *In re Wamerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994), the displaying, allowing, wireless, address, information, transmitting, providing, determining, sending, executing, and assigning steps recitation is considered intangible because those steps are simply an abstract construct, such as a disembodied data structure and a method of making it, wherein those recitations involve more than a manipulation of an abstract idea and therefore is non-statutory under 35 USC 101. Because the independently claimed invention does not recite a useful, concrete, and tangible result, such that it is considered not within technological arts so that it uses technology in a non-trivial matter. Finally under *Ex parte Bowman*, 61 USPQ2d 1665 (Bd. Pat. App. & Inter. 2001) (unpublished but cited for analysis rather than precedent), in which an invention

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disclosed and claimed directed to a human merely making mental computations and manually plotting results on a paper chart is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the United States Constitution. In this independently claimed invention, the steps of displaying, allowing, wireless, address, information, transmitting, providing, determining, sending, executing, and assigning are considered nothing more than an abstract idea since it is not tied to any technological art. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 6-10, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Owensby (WO 00/35216). Owensby is considered to disclose a method, apparatus, and program comprising:

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displaying a guide code corresponding to a network address of an advertisement object (page 15 lines 13-31); and

allowing a user to transmit said guide code (page 17 line 14) wherein Owensby also includes means for or instructions thereof. Owensby is considered to also disclose the claimed wireless network (page 16 line 14), mobile telephone (page 16 line 4), advertisement information (page 20 line 10), good or service information (page 30 line 10 wherein the disclosed targeted advertisement of particular interest is considered equivalent to the claimed information related to good or service based on the broadest reasonable interpretation of claim language based on the specification discussion), transmitting an address corresponding to a code (page 16 line 16), benefit provision transmission (page 20 line 23), and identity code transmission (page 20 line 21).

Claims 16-27, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (WO 01/45379). Lee is considered to disclose a method and system comprising:

assigning guide codes respectively to each advertiser or each item of the advertiser, each of said guide codes being linked with the Web site of the advertiser or the item (page 12 lines 11-21 wherein the disclosed event is considered equivalent to the claimed guide code because advertisements induce online participation for advertisers);

upon perceiving a given one of said guide codes, allowing a user to gain access to a guide code server through a mobile communication service system using his or her

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mobile communication terminal and to enter the given guide code in said terminal under the guidance of an automatic response service system (page 12 lines 22-31);

when said given guide code is entered, searching a guide code database for Web site address information corresponding to the entered guide code and sending the searched Web site address information to a voice mail box belonging to a telephone number of said mobile communication terminal of the user (page 16 lines 2-13 wherein the disclosed brokerage is considered to anticipate the claimed voice mail box, based on the broadest reasonable interpretation from the specification discussion of voice mail box, because both the disclosure and claimed feature server to store incentive messages for later user access); and

allowing said user to open said voice mail box associated with the telephone number of his or her mobile communication terminal, extracting information stored in said voice mail box and confirming a Web address of an advertising site corresponding to said given guide code on the basis of the extracted information (page 16 lines 20-28); or alternatively

at least one mobile communication terminal **130** connected to a mobile communication service system over a radio communication network;

an automatic response service system **250** or **350** connected to said mobile communication service system for sending guide code entry guide information to said mobile communication terminal in a mode of entering a specific one of the guide codes, inserted in a given advertisement, using said mobile communication terminal;

a guide code database **152** or **352** for storing information about Web addresses of advertising sites of advertisers;

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a server for **200** or **300** or **400** extracting information about a Web address of an advertising site of an advertiser corresponding to said specific guide code from said guide code database when a user enters information containing said specific guide code using said mobile communication terminal under the guidance of said automatic response service system and then generating short-message information based on the extracted Web site address information; and

a mail box server system **310** Or **450** connected to said mobile communication service system for storing said short-message information from said server in a mail box belonging to a telephone number of said mobile communication terminal and reproducing the stored short-message information for user's confirmation. Lee is considered to also disclose the claimed transaction code (page 23 lines 13-18), short message (page 19 line 17), telephone number entry guide code association (page 19 line 9 wherein the disclosed registration is considered to be patentably equivalent to the claimed code entry number association because both use information to project a user code), membership information (page 19 line 7), voice message check (page 25 line 6), free call time (page 3 line 8), predetermined money and valuables (page 3 line 11), voice mail box service (page 16 line 3 wherein the disclosed brokerage service is considered to anticipate the claimed mail box service because both notify a user of messages regarding a communication service), and terminal free call (page 6 line 5).

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Claims 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by non-patent literature reference U, cited with this Office action. Reference U is considered to disclose a method comprising:

assigning the guide codes respectively to each advertiser or each item of the advertiser, each of said guide codes being linked with the Web site of the advertiser or the items of the merchandiser so that people can perceive the Web addresses of the advertising sites by corresponding guide codes (wherein the disclosed filtering options are considered to anticipate the claimed guide code assignment because in both cases, users may link or forward incentive advertisement associated messages);

allowing people to gain access to a guide code server through a gateway using his or her mobile communication terminal and enter a specific one of said guide codes in said terminal (wherein the disclosed partnership is considered patentably equivalent to the claimed people gateway guide code access because both achieve code accessibility between separate entities); and

when said specific guide code is entered, searching a guide code database for a Web address of an advertising site of an advertiser corresponding to the entered guide code and forwarding said mobile communication terminal to the searched Web site address including guide codes is appended with a given one of sub codes assigned respectively to items of goods being on sale in an advertising site of a corresponding one of said advertisers and then inserted and marked in a corresponding advertisement together with the given sub code, each of said sub codes being composed of numerals and being directly linked to a site selling an associated goods item, whereby said peoples gain direct access to a specific selling site by connecting to a radio internet

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network using his or her mobile communication terminal and entering one of said sub codes corresponding to the specific selling site in said terminal (wherein the disclosed mail.com partnership with numerous internet marketers is considered to the same as the claimed advertiser guide code searching because mobile telephony allows web site address searching in both the claimed invention and the prior art teachings of reference U).

Claim 33 is rejected under 35 U.S.C. 102(b) as being anticipated by Christensen et al. (US 5,710,886). Christensen U is considered to disclose a system comprising:

charging a user for the purchased service or goods in combination with or separately from the telephone fees of a mobile communication terminal of said user, so as to secure anonymity and security of said user when he or she reserves or purchases a specific service or goods on the Internet using guide codes (column 8 lines 7-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 5, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby in view of Lee. Owensby is considered disclose the claimed invention as discussed in the anticipatory rejection above except for the claimed internet network, website address, and good or service input purchase code mobile telephone cost charge. Marsh is considered to disclose the claimed internet network on page 9 lines 1-6, website address on page 13 line 26 wherein the disclosed homepage is considered equivalent to the claimed URL website address, and good or service input purchase code mobile telephone cost charge at page 19 lines 5-30. It would have been obvious to one skilled in the art to combine the teachings of Owensby with the teachings of Lee to provide the claimed internet network, website address, and good or service input purchase code mobile telephone cost charge for the purpose of allowing users to make an informational choice for a selected item of information with a mobile telephone based on advertisement codes.

Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of reference U. Lee is considered disclose the claimed invention as discussed in the anticipatory rejection above except for the claimed one-click membership.

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Reference U is considered to disclose the claimed one-click membership because it is considered that the disclosed single button reply is patentably equivalent to the claimed one-click membership. It would have been obvious to one skilled in the art to combine the teachings of Lee with the teachings of reference U to provide the claimed one-click membership for the purpose of allowing users to make a one step informational choice for a selected item of information with a mobile telephone based on advertisement codes.

Claims 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Christensen. Lee is considered disclose the claimed invention as discussed in the anticipatory rejection above except for the claimed terminal free-call time.

Christensen is considered to disclose the claimed terminal free-call time because it is considered that the disclosed single button reply is patentably equivalent to the claimed terminal free-call time. It would have been obvious to one skilled in the art to combine the teachings of Lee with the teachings of Christensen to provide the claimed terminal free-call time for the purpose of allowing users to make a one step informational choice for a selected item of information with a mobile telephone based on advertisement codes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Billström (US 5,729,537) and Williams (US 6,075,971) are

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considered to teach the concept of mobile telephone commerce with voice mail boxes, such that advertisements can be incorporated for those disclosures.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose voice telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The facsimile transmission telephone numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9306
Non-Official/Draft	(703) 872-9325


STEPHEN GRAVINI
PRIMARY EXAMINER

smg
June 7, 2004